

REMARKS

This is response to the Final Office action (Paper No. 20060608) mailed on 20 June 2006.

Claims 1-5, 8, 9 and 11-17 are pending in this application. Claims 1, 4, 9 and 15 are amended to assist the examiner and to expedite compact prosecution of this application, considering the examiner's suggestion made on 8 June 2006, wherein the examiner suggested considering the incorporation of the features disclosed in the specification at page 10, lines 11 and 12 into claims. Claim 3 has been canceled without disclaiming its subject matter.

Since the amendments will place the case either in condition for allowance or in better form for appeal, it is respectfully requested that the amendments be entered.

I. Claim Rejections – 35 USC §103

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. Claims 1, 2, 4, 5, 8, 9, 11, 12, 13, 14, 16 and 17 stand rejected under 35 U.S.C. 103(a)

as being unpatentable over Ryman in view of European Patent Application (EP 0 746 051) and Kojima et al. or Monnett.

- a. Ryman teaches a device for a broadband surge protector, but fails to teach or suggest the input connector with a connection to a ground base transceiver station as claimed in the present invention.
 - i. Figure 3 of Ryman refers to first end 15 as a "feed-end" or "ground-based equipment end", however, this is not transceiver station or a BTS as described in the present invention
 - ii. This is relevant in regards that the present invention claims a T-bias apparatus, while Ryman basically refers to a surge protector that includes a DC blocking device, there is no teaching in regards to a base transceiver station. Ryman mentions uses with antenna, but not specifically a base transceiver station (BTS).
- b. As mentioned in MPEP 706.02(j), there must be a reasonable expectation of success. However, if Ryman is modified by a conductor shaft being inserted in the reception tube so that the first conductor and second conductor are assembled with each other, there could be problems. Ryman specifically discloses portion 34 which could be problematic in assembling the shaft in such a manner.
- c. Claim 1 has been amended to add the feature of "the direct current power being supplied to said first conductor through filter and said fixing pin." The

examiner argued that Sato et al. discloses EMI filter using coils and dielectric materials. However, the feature of “the direct current power being supplied to said first conductor through filter and said fixing pin” is not taught or suggested by Ryman in view of European Patent Application (EP 0 746 051) and Kojima et al. or Monnett or in combination with Sato et al.

- d. Regarding claim 9, claim 9 has been amended to incorporate the feature of “the direct current supplied to said first conductor and radio frequency signal are transmitted to an antenna tower, the radio frequency signal is not outputted to said fixing pin to which the direct current power is applied, accommodated through an impedance of said fixing pin being indefinite through a coil constructing said filter.” This feature is not taught or suggested by the references.

Therefore, claims 1, 2, 4, 5, 8, 9, and 11-17 are not obvious over the prior art.

B. Claim 15 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Ryman in view of European Patent Application (EP 0 746 051) and Sato et al.

- a. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*,

424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

- b. The examiner merely argued that “Sato et al. discloses EMI filter using coils and dielectric materials. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Ryman with the EMI filter, as taught by Sato et al., to effectively suppress the EMI noise.
- c. However, an EMI filter in the recess is not taught or suggested. Sato only provides an EMI filter, but does not teach or suggest that it should be in recess. The examiner’s reasoning is at most that the EMI filter can be incorporated into Ryman modified by EP ‘051 at a certain position.
- d. Please also note that the Federal Circuit has mentioned that “[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious.” *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964).
- e. Therefore, claim 15 is patentable.

In view of the above, all claims are submitted to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections is requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fees are incurred by this Amendment.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. E. Bushnell', is written over a horizontal line.

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